Remarks

Claims 1-25 are pending in the subject application. By this amendment, the applicants have amended claims 6-9, 13, and 16 and has canceled claims 1-5, 10-12, 17-20, and 24. No new subject matter has been added by this amendment. For example, in claims 7-9, the dependent claim was misnumbered. By this Amendment, the correct claim dependency (claim 6) is recited in claims 7-9. Support for the amendments to the claims can be found throughout the subject application. Accordingly, claims 6-9, 13-16, 21-23, and 25 are now before the Examiner for consideration.

The amendments set forth herein should not be interpreted to indicate that the applicants have agreed with, or acquiesced to, the rejections set forth in the outstanding Office Action. Favorable consideration of the claims now presented, in view of the remarks and amendment set forth herein, is earnestly solicited.

As an initial matter, the applicants wish to thank Examiner Badio for the indication of allowable subject matter in this case. In accordance with the Examiner's suggestions, the applicants have rewritten claims 6 and 13 in independent form. Thus, the applicants believe that the currently pending claims are in condition for allowance, and such action is respectfully requested.

Claims 2-5 and 20 have been objected to under 37 C.F.R. §1.75 as being substantial duplicates of claim 1. The applicants respectfully submit that claims 2-5 and 20 are not substantial duplicates of claim 1. However, as noted above, the objection of claims 2-5 and 20 is moot in view of the cancellation of these claims. Accordingly, reconsideration and withdrawal of this objection under 37 CFR 1.75 is respectfully requested.

Claim 1-5, 8, 9, 17-20, and 23 have been rejected under 35 U.S.C. §112, first paragraph. As noted above, the rejection of claims 1-5 and 17-20 is rendered moot in view of the cancellation of these claims. The applicants respectfully submit that claims 8, 9, and 23 are fully enabled by the subject specification. Claims 8, 9, and 23, as currently presented, depend from claim 6, which has been rewritten in independent form to place the claim in condition for allowance. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. §112, first paragraph is respectfully requested.

Claims 1-5, 7-9, 16-20, and 23-25 have been rejected under 35 U.S.C. §112, second paragraph. As noted above, the rejection of claims 1-5, 17-20, and 24 is rendered moot in view of the cancellation of these claims. The applicants respectfully submit that claims 7-9, 16, 23, and 25 identify specific quinols and are therefore definite. For example, claims 7-9 and 23 identify a specific quinol, namely that recited in claim 6, which has been rewritten in independent form to place the claim in condition for allowance. Claim 25 provides specific identification of a quinol, namely that recited in claim 13, which has been rewritten in independent form to place the claim in condition for allowance. Further, in order to expedite prosecution, claim 16 has been rewritten in independent form to clearly recite a specific quinol, 2-(1-adamantyl)-3-hydroxyestra-1,3,5(10)-trien-17-one. Accordingly, reconsideration and withdrawal of this rejection under 35 U.S.C. §112, second paragraph, is respectfully requested.

Claims 21 and 22 have been rejected under 35 U.S.C. §102(b) as anticipated by Lunn *et al.* (Tetrahedron, 1968). The applicants respectfully traverse this rejection because the Lunn *et al.* reference neither teaches nor suggests the applicant's quinol or pharmaceutical composition.

It is basic premise of patent law that, in order to anticipate, a single prior art reference must disclose within its four corners, each and every element of the claimed invention. In *Lindemann v. American Hoist and Derrick Co.*, 221 USPQ 481 (Fed. Cir. 1984), the court stated:

> Anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim. *Connell v. Sears Roebuck and Co.*, 220 USPQ 193 (Fed. Cir. 1983); *SSIH Equip. S.A. v. USITC*, 216 USPQ 678 (Fed. Cir. 1983). In deciding the issue of anticipation, the [examiner] must identify the elements of the claims, determine their meaning in light of the specification and prosecution history, and identify corresponding elements disclosed in the allegedly anticipating reference. *SSIH, supra; Kalman v. Kimberly-Clarke*, 218 USPQ 781 (Fed. Cir. 1983) (emphasis added). 221 USPQ at 485.

In *Dewey v. Almy Chem. Co. v. Mimex Co.*, Judge Learned Hand wrote:

> No doctrine of the patent law is better established than that a prior patent . . . to be an anticipation must bear within its four corners adequate directions for the practice [of the subsequent invention] . . . if the earlier disclosure offers no more than a starting point . . . if it does not inform the art without more how to practice the new invention, it has not correspondingly enriched the store of common knowledge, and it is not an anticipation. 52 USPQ 138 (2nd Cir. 1942).

The applicants respectfully submit that Lunn *et al.* do not disclose ***2-(1-adamantyl)-3-hydroxyestra-1,3,5(10)-trien-17-one*** as recited in claims 21 and 22. Instead, as noted in the Office Action, the Lunn *et al.* reference teaches the crystallization and production of ***2-(adamantyl-1)-estrone*** (compound #2, see page 6774). The skilled artisan would readily acknowledge that the quinol 2-(1-adamantyl)-3-hydroxyestra-1,3,5(10)-trien-17-one is not one and the same as the compound 2-(adamantyl-1)-estrone. Because Lunn *et al.* do not disclose the claimed quinol, the applicant's claims cannot be said to be anticipated by Lunn *et al.* Accordingly, the applicants respectfully request reconsideration and withdrawal of the rejection set forth under 35 U.S.C. §102(b).

Claims 1-5, 8-12, 17, 20, and 23-25 have been rejected under 35 U.S.C. §103(a) as being obvious over Chamberlain *et al.* (U.S. Patent No. 6,258,856) in view of Jin *et al.* (U.S. Patent No. 2,910,486). The applicants respectfully traverse this rejection because neither of the references, alone or in combination, teaches or suggests the applicants' claimed invention.

The rejection of claims 1-5, 10-12, 17, 20 and 24 is rendered moot in view of the cancellation of these claims. The applicants respectfully submit that claims 8, 9, 23, and 25 cannot reasonably be said to be obvious. For example, claims 8, 9, and 23, as currently presented, depend from claim 6, which has been rewritten in independent form to place the claim in condition for allowance. Claim 25 depends from claim 13, which has also been rewritten in independent form to place the claim in condition for allowance. Accordingly, reconsideration and withdrawal of this rejection under 35 U.S.C. §103, is respectfully requested.

In view of the foregoing remarks and the amendments above, the applicants believe that the currently pending claims are in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees under 37 CFR §§1.16 or 1.17 as required by this paper to Deposit Account No. 19-0065.

The applicants also invite the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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MHE/la

Attachment: Amendment Fee Transmittal Letter